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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/575,801      | 11/30/2006  | Matthew W. Weismiller | 7175-202433         | 5179             |

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BARNES & THORNBURG, LLP  
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INDIANAPOLIS, IN 46204

EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3686

NOTIFICATION DATE

DELIVERY MODE

05/26/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

indocket@btlaw.com

### Office Action Summary

**Application No.**

10/575,801

**Applicant(s)**

WEISMILLER ET AL.

**Examiner**

Natalie A. Pass

**Art Unit**

3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 9 March 2010. Claims 1, 8, 14 have been amended. Grounds of rejection for claims 1-20 are set forth in detail below.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Newly amended claims 1, 8, 14 recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- “each tag lacking any voice communication capability” as disclosed in claim 1 at line 7, claim 8, at lines 5-6, and claim 14 at line 3, respectively;

- “that are separate and distinct from the tags” as disclosed in claim 1, at line 10, and claim 8 at lines 11-12, respectively;
- “the plurality of communicators being separate and distinct from the plurality of tags,” as disclosed in claim 14, at lines 6-7.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable to find any support for this newly added language within the specification as originally filed on 30 November 2006. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

(B) Claims 2-7, 9-13, 15-20 incorporate the features of claims 1, 8, 14, through dependency, and are also rejected. See *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990).

4. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can be

amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 30 November 2006.

5. The rejection of claims 1-13 a 35 U.S.C. 112, second paragraph, as being indefinite is hereby withdrawn due to the amendment filed 9 March 2010.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 4, 6-11, 14-15, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosner, U.S. Patent Application Publication Number 2003/0022696 for substantially the same reasons given in the previous Office Action (paper number 20091120), and further in view of Barnes, U.S. Patent Application Publication Number 2003/10220835. Further reasons appear hereinbelow.

**NOTE:** The following rejections assume that the subject matter added in the 9 March 2010 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and

rejections made in sections 2-4 above in the next communication sent in response to the present Office Action.

(A) Claim 1 has been amended to recite the limitations

- "including tags that are attached to assets, each tag lacking any voice communication capability," in line 7;
- "that are separate and distinct from the tags," in line 10;
- "wherein the locating and tracking system and the communication system are linked so that a specific location of an asset having one of the plurality of tags attached thereto is determinable by using a voice command spoken into one of the voice-activated communicator," in lines 11-14.

(B) Claim 14 has been amended to recite the limitations

- "each tag lacking any voice communication capability," in line 3;
- "the plurality of communicators being separate and distinct from the plurality of tags," in lines 6-7;
- "spoken into one of the plurality of communicator," in lines 8-9.

As per newly amended claims 1 and 14, Rosner discloses a system and method as analyzed and discussed in the prior Office Action (paper number 20091120).

Rosner fails to explicitly disclose a system and method further comprising:

including tags that are attached to assets, each tag lacking any voice communication capability;

the plurality of communicators being separate and distinct from the plurality of tags; wherein the locating and tracking system and the communication system are linked so that a specific location of an asset having one of the plurality of tags attached thereto is determinable by using a voice command spoken into one of the voice-activated communicator.

However Barnes teaches a system and method further comprising including tags that are attached to assets, each tag lacking any voice communication capability (Barnes; paragraphs [0107], [0263]);

the plurality of communicators being separate and distinct from the plurality of tags (Barnes; paragraphs [0107], [0263], [0298]); and

wherein the locating and tracking system and the communication system are linked so that a specific location of an asset having one of the plurality of tags attached thereto is determinable by using a voice command spoken into one of the voice-activated communicator (Barnes; paragraphs [0315]-[0319]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Rosner to include these limitations, as taught by Barnes, with the motivations of “provid[ing] functions based on location data ... [...] ... to wirelessly exchange select information with other users and systems, to restrict and/or monitor the use of the device based on user provided parameters ... [...] ... triggering an action based on a change in location and sensed data ... [...] ... contemporaneously maintaining a wireless voice and data

link" (Barnes; paragraph [0014]) and allowing "the authorized user ... [to] ... program the monitoring and restriction instructions remotely by establishing a communication link and transmitting an authorized user request or through voice commands ... [...] ... prior to supplying the device 101 to the restricted user" (Barnes; paragraph [0318]).

The remainder of claims 1 and 14 is rejected for the same reasons given in the prior Office Action (paper number 20091120, section 5, pages 5-7), and incorporated herein.

(C) Amended claim 8 repeats the features of amended claim 14, respectively, and is therefore rejected for the same reasons given above in the rejections of claim 14, and incorporated herein.

The motivations for combining the respective teachings of Rosner and Barnes are as given in the rejection of claim 1 above, and incorporated herein.

(D) Claims 2, 4, 6-7, 9-11, 15, 20 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20091120, section 5, pages 5-8), and incorporated herein.

The motivations for combining the respective teachings of Rosner and Barnes are as given in the rejection of claim 1 above, and incorporated herein.

8. Claims 5, 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosner, U.S. Patent Application Publication Number 2003/0022696 and Barnes, U.S. Patent Application Publication Number 2003/10220835, as applied to claims 1, 14-15 above, and further in view of



Werb et al, U.S. Patent Number 6456239 for substantially the same reasons given in the previous Office Action (paper 20091120). Further reasons appear hereinbelow.

(A) Claims 5, 16-17 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20091120, section 7, pages 9-10), and incorporated herein.

The motivations for combining the respective teachings of Rosner and Barnes are as given in the rejection of claim 1 above, and incorporated herein.

9. Claims 12-13, 18-19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosner, U.S. Patent Application Publication Number 2003/0022696 and Barnes, U.S. Patent Application Publication Number 2003/10220835, as applied to claims 8, 14 above, and further in view of Shostak, U.S. Patent Number 6901255 for substantially the same reasons given in the previous Office Action (paper 20091120). Further reasons appear hereinbelow.

(A) Claims 12-13, 18-19 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20091120, section 8, pages 10-12), and incorporated herein.

The motivations for combining the respective teachings of Rosner and Barnes are as given in the rejection of claim 1 above, and incorporated herein.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosner, U.S. Patent Application Publication Number 2003/0022696 and Barnes, U.S. Patent Application

Publication Number 2003/10220835, as applied to claims 1-2 above, and further in view of Squibbs, U.S. Patent Application Publication Number 2002/0077772 for substantially the same reasons given in the previous Office Action (paper 20091120). Further reasons appear hereinbelow.

(A) Claim 3 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 20091120, section 9, page 12), and incorporated herein.

The motivations for combining the respective teachings of Rosner and Barnes are as given in the rejection of claim 1 above, and incorporated herein.

### ***Response to Arguments***

11. Applicant's arguments filed 9 March 2010 with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of

this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**14. Any response to this final action should be mailed to:**

Box AF  
Commissioner of Patents and Trademarks  
Washington D.C. 20231

**or faxed to:** (571) 273-8300.

For formal communications, please mark "EXPEDITED PROCEDURE".

15. For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on 9-6:30 Monday - Thursday and alternate Fridays.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./  
Examiner, Art Unit 3686  
May 22, 2010

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 3686